

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed April 2, 2004 (the "Office Action"). Claims 1-27 are pending in the application. In the Office Action, Claims 1-27 were rejected. Applicants have amended Independent Claims 1, 13, 23, and 27. Applicants respectfully submit that no new matter has been added by the amendments. For at least the reasons discussed below, Applicants respectfully request reconsideration and favorable action in this case.

#### **Section 103 Rejections**

The Office Action rejects Claims 1-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,529,599 to Gorshe ("*Gorshe*"). Applicants respectfully traverse all rejections therein.

According to M.P.E.P. §2143, to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.

Applicants submit that the third criteria necessary to establish a *prima facie* case of nonobviousness has not been met, because the cited reference alone fails to teach, suggest, or disclose each and every element of the claimed invention. For example, amended Independent Claim 1 recites, "determining a higher priority item between the first and second equipment items based on the first and second equipment types." *Gorshe*, in summary, merely discloses prioritizing working units' access to a protection bus based on the extent that their failures affect the network,<sup>1</sup> which is *not based on an equipment type* of the equipment item making the protection request. As an example, *Gorshe* discloses the number of channels or circuits affected by the failure as factors for determining the priority of a working unit's access to the protection bus. Accordingly, Applicants submit that Claim 1 and its dependents are patentably distinct *Gorshe*.

Additionally, Independent Claim 13 recites, "evaluating a priority of the request based on the request type and the equipment type relative to all other outstanding protection requests

---

<sup>1</sup> Col. 7, Lines 9-23.

for equipment items in a protection group with the equipment item.” In considering the patentability of Claim 13, Applicants submit that each and every word of Claim 13 must be considered. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). In particular, the phrase “evaluating a priority of the request based on the request type *and* the equipment type” must be considered.

To begin with, *Gorshe* fails to teach or suggest evaluating a priority of the request based on the request type. As discussed above, *Gorshe* merely discloses prioritizing working units’ access to a protection bus based on the extent that their failures affect the network,<sup>2</sup> which is *not based on a request type or an equipment type* as claimed in the Application. Furthermore, *Gorshe* fails to teach or suggest determining a priority of a request based on *both* a request type and an equipment type. Accordingly, Applicants submit that Claim 13 and its dependents are patentability distinct from *Gorshe*.

Independent Claims 18, 23, and 27 recite limitations that are similar, although not identical, to the limitation of Claim 13 discussed above. Therefore, these claims are allowable for reasons analogous to those discussed above in connection with Claim 13. Claims 19-22 and 24-26 depend from independent Claims 18 and 23, respectively, and are thus also patentable over the cited art.

---

<sup>2</sup> Col. 7, Lines 9-23.

**CONCLUSIONS**

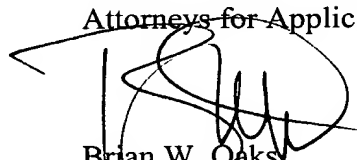
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although no other fees are believed to be due, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
~~Attorneys for Applicants~~



Brian W. Oaks  
Reg. No. 44,981

Date: 7/2/04

**CORRESPONDENCE ADDRESS:**  
BAKER BOTTS L.L.P.  
2001 Ross Avenue, Suite 600  
Dallas, Texas 75201-2980  
Tel. 214.953.6986

Customer Number: **05073**